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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,118	02/23/2006	Miroslav Simonek	JANK.P-001-NP	2940

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Oppedahl Patent Law Firm LLC  
P O Box 5940  
Dillon, CO 80435-5940

EXAMINER
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SMITH, CHAIM A

ART UNIT	PAPER NUMBER
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1782

NOTIFICATION DATE	DELIVERY MODE
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08/30/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-oppedahl@oppedahl.com  
mail-log@oppedahl.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,118	<b>Applicant(s)</b> SIMONEK, MIROSLAV	
	<b>Examiner</b> CHAIM SMITH	<b>Art Unit</b> 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph for the same reasons given in the Office Action dated 07 April 2010.

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding "creating of a funnel shaped opening while opening the wrapping", no particular shape that the wrapper would assume upon opening has been previously claimed or disclosed, therefore this seen to raise the issue of new matter.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randak, Sr. US 2,990,100 as further evidenced by Comino et al. EP 0 642 993 and Badura EP 0 779 040 for the same reasons given in the Office Action mailed 07 April 2010.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comino et al. EP 0 642 993 as further evidenced by Randak, Sr. US 2,990,100 for the same reasons given in the Office Action mailed 07 April 2010.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Badura EP 0 779 040 for the same reasons given in the Office Action mailed 07 April 2010.

8. Claim 1 now recites “attached together along their margins partially, characterized in that parts are attached together along their margins partially from one-third to one-half of the circumference of the parts.” It is not seen how a repetition of the limitation further adds to the claim. Further the use of comprising language (characterized in that) is not further limiting in that it allows for the parts to be not only attached from one-third to one-half along said margins, but along the entire margin as well.

9. Claim 2 now recites “creating a funnel shaped opening while opening the wrapping”. It is not seen that patentability can be conferred by the particular shape of the wrapping’s opening absent evidence of unexpected results (MPEP § 2144.04 IV.B.). Nevertheless the opening of a funnel can be defined as a tube or shaft the opening of which is no different than the top of any tube or a shaft. When squeezed open for the

deposition of waste material the wrapping of Randak, Sr forms a funnel opening (fig. 1). When squeezed open for the deposition of chewing gum Badura clearly discloses a funnel opening (Badura translation page 5, paragraph 1, Badura col. 2, paragraph 5 and fig. 2). Comino is clearly providing a funnel shaped opening in a wrapping for used chewing gum (col. 3, paragraph 2 and fig. 2).

### ***Response to Arguments***

10. Applicant's arguments filed 20 June 2010 have been fully and carefully considered but they are not persuasive.

11. Regarding the rejection of claim 1 under 35 USC § 112 first paragraph, the applicant's clarification in the reply does not further enable the specification with respect to the mechanical construction of the wrapping. While the specification discloses the use of false tabs, said tabs do not appear in figures 2 – 4, that is to say the figures do not depict any “hidden” tabs since as shown in the figures no tabs appear to be present, hidden or otherwise. It is further noted that (specification, top of page 3) the wrapping is “folded in such a way as to allow both parts 1, 2 [of the wrapper] to stick together with their whole surfaces”, which is to say that said parts would be adhered together, in which case it is unknown how the wrapper would be opened by depressing two sides. Applicant's further explanation in the reply does not further clarify the structural relationship of the elements in the specification. Further, while the examiner appreciates that the application was originally written in a language other than English, that does not improve on the current translation of the disclosure. Also as noted in the rejection, the use of “false” tabs further indicates that said tabs need not necessarily be

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present just as the "false" bottom of a container indicates that said bottom is removable and may or may not be present in the container.

12. Regarding the rejection of claim 1 applicant urges that the particular amount of circumferential attachment, that is to say, the placement of any attachments and/or the particular length of the wrappings margins which would be attached together would not have been an obvious matter of choice. This urging is not persuasive. Where the only difference between the prior art and the claims is a recitation of relative dimensions, in this case the length or amount of attachment of the wrapping, and the claimed device and the prior art device having the claimed relative dimensions would not perform differently the claimed device is not patentably distinct from the prior art device (MPEP § 2144.04 IV.A.).

13. Further regarding applicants request for an examiner's affidavit under 37 C.F.R. § 1.104(d)(2) (hereinafter referred to as rule 104): Rule 104(d)(2) states:

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

14. Since the examiner has not relied on common knowledge in the art, that is, the taking of "official notice", but on legal precedence, an examiner's affidavit has not been provided. See further MPEP § 2144.03 C.

15. Regarding claim 2 applicant urges that the behavior of undisciplined persons and the size of the prior art wrappings for gum disposal would cause said undisciplined persons not to use the prior art wrappings. These urgings are not persuasive as

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applicant is merely stating applicant's opinion that the prior art is not equivalent to applicants invention. Further applicant appears to be arguing the size of the prior art wrappers with respect to applicant's wrapper. Regarding these urgings it is noted that no particular size regarding the wrapping has been claimed making it unclear, particularly in view of applicant's argument, why said undisciplined persons would choose to use applicant's wrapper when the prior art wrappers would be considered unsuitable by said persons. It is further noted that the claim is directed to the use of a wrapping and not the use of the wrapping by any particular group of people.

16. Regarding applicants urgings against the individual prior art wrappings, these urgings are not found persuasive. Where the only difference between the prior art and the claims is a recitation of relative dimensions, in this case the length or amount of attachment of the wrapping, and the claimed device and a device having the claimed relative dimensions would not perform differently the claimed device is not patentably distinct from the prior art device (MPEP § 2144.04 IV.A.).

17. Applicant further urges that Badura discloses a wrapping to be used only with powdery or lumpy waste. This urging is not found persuasive. Badura specifically discloses the wrapping is in particular for waste from chewing gum (Badura translation, page 5 paragraph 1). Further it is not understood how used chewing gum would adhere to the edge of the opening of the wrapper of Badura and not to the edge of applicant's wrapper.

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18. Further the examiner notes that the applicant is arguing size differences between the prior art and applicant's invention, that is, applicant is urging limitations which are not found in the claims.

***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAIM SMITH whose telephone number is (571)270-7369. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. S./  
Chaim Smith  
Examiner, Art Unit 1782  
25 August 2010

/Rena L. Dye/  
Supervisory Patent Examiner, Art Unit 1782